

REMARKS

Claims 19-23, 25-28, 30-31, 45-47, 49-55 and 62-80 are pending in the above-captioned patent application following this amendment. Claims 18-31 and 33-61 were rejected. Claims 19-23, 25, 30-31, 45-47 and 49-55 have been amended, claims 18, 24, 29, 33-44, 48 and 56-61 have been canceled without prejudice, and claims 62-80 have been added, all for the purpose of expediting the patent application process in a manner consistent with the goals of the Patent Office pursuant to 65 Fed. Reg. 54603 (September 8, 2000), even though the Applicant believes that the previously pending claims were allowable. Additionally, claims 18, 24 and 29 have been rewritten in independent form as new claims 62, 69 and 72, for the purpose of the Applicant traversing these claims. Further, a Request for Continued Examination has been filed concurrently herewith.

Support for the amendments to the claims and for the new claims can be found throughout the originally filed application, including the originally filed claims, the drawings and the specification. More specifically, support for the amendments to the claims and for new claims 62-81 can be found at least in previously pending claims 18-31 and 33-61, in Figures 1, 2A-2F, 5 and 6, and in the specification at page 4, line 15 through page 8, line 10, at page 9, line 10 through page 11, line 17, and at page 12, line 17 through page 16, line 4.

No new matter is believed to have been added by this amendment. Consideration of the application is respectfully requested.

Double Patenting Objections

Claim 44 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 48. Further, claim 56 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 58. Although the Applicant disagrees with the objection, for reasons unrelated to this objection, the Applicant has canceled claims 44, 48, 56 and 58 without prejudice by the amendment. Thus, the objection is believed to be moot.

Rejections Under 35 U.S.C. §102

Claims 18-31 and 33-61 are rejected under 35 U.S.C. §102(b) as being anticipated by Van Teunenbroek et al. (US 6,739,935). Claims 33-44, 48 and 56-61

have been canceled without prejudice by this amendment. Therefore, the rejection of claims 33-44, 48 and 56-61 is believed to be moot.

However, the Applicant respectfully traverses the rejection of claims 18, 24 and 29, which have been rewritten in independent form as new claims 62, 69 and 72, respectively, on the grounds that the cited reference does not teach or suggest the features of these claims, as provided below.

The Patent Office states in its rejection that "any surface such as a room floor where two players meet can be broadly and reasonably interpreted as players being in 'designated positions'. Also Teunenbroek inherently teaches two players to come close to each other to play a contact/game and that can be broadly and reasonably interpreted as 'being on the same position'." The Applicant respectfully submits that this reading of Van Teunenbroek et al is unreasonable, and even if it were reasonable, still does not support the rejection under 35 U.S.C. §102(b).

Van Teunenbroek et al is directed toward toy articles 1, 2, that can be coupled together and moved relative to one another to cause permanent damage to one of the toy articles. (Col. 2, lines 34-37 and Col. 3, lines 7-9). The rationale of the Patent Office quoted above discusses the players having designated positions, i.e. where the players sit or stand. Although the Applicant disagrees that Van Teunenbroek et al teaches that the players have designated positions, this feature is really irrelevant because the claim language does not indicate the players have designated positions. Both Van Teunenbroek et al and the rationale of the Patent Office provided above do not indicate or suggest that the toy articles have designated positions. Although Van Teunenbroek et al. mentions a playing board in the context of using handles 32 of the toy articles to allow the toy articles to stand up. There is absolutely no teaching or suggestion that the toy articles move around on designated positions on the playing board, or that a battle occurs once two toy articles occupy the same designated position on a playing surface.

In fact, the Patent Office admits in its rejection under 35 U.S.C. §103(a) that Van Teunenbroek et al "does not expressly teach game being played in a board game environment having designated positions and playing pieces moving, engaging and being deformed." (See page 4 of Final Rejection). Because these features or steps are

not taught by Van Teunenbroek et al, the rejection under 35 U.S.C. §102(b) is improper and should be withdrawn.

Moreover, Van Teunenbroek et al does not teach or suggest that a set of toy articles are used, with two or more toy articles in the set having specific patterns of movement on the playing board. Nor does Van Teunenbroek et al teach or suggest that one of the toy articles in the set is chosen to be a king. Additionally, Van Teunenbroek et al does not teach or suggest that the deformed toy article is removed from the game board. In fact, Van Teunenbroek et al does not describe any rules of a game that is to be played, i.e. movement along a playing board, different classes of toy articles, board positioning, etc. Van Teunenbroek et al essentially only describes the toy articles being coupled together and one being permanently damaged.

In direct contrast to Van Teunenbroek et al, claim 62 is directed toward a method that requires the steps of “moving a first deformable game piece along a playing surface having a plurality of designated positions; moving a second deformable game piece along the playing surface; engaging the first game piece with the second game piece when the game pieces occupy the same designated position as one another on the playing surface; and moving the engaged game pieces relative to each other to cause a deformation of one of the engaged game pieces; and removing the deformed game piece from the playing surface.” These steps are not taught or suggested by Van Teunenbroek et al. Thus, Van Teunenbroek et al does not support a rejection of claim 62 under 35 U.S.C. §102(b), and the rejection should be withdrawn. Because claims 20-23, 45-47 and 63-68 depend directly or indirectly from claim 62, a rejection of these claims would likewise not be supported by Van Teunenbroek et al.

Further, claim 69 is directed toward a method requiring the steps of “the first player providing a first set of game pieces that includes a first deformable game piece and selecting one of the game pieces in the first set to be a first king; the second player providing a second set of game pieces that includes a second deformable game piece and selecting one of the game pieces in the second set to be a second king; moving a first deformable game piece along a playing surface having a plurality of designated positions; moving a second deformable game piece along the playing surface; engaging the first game piece with the second game piece; and moving the engaged game

pieces relative to each other to cause a deformation in one of the engaged game pieces.” These steps are not taught or suggested by Van Teunenbroek et al. Thus, Van Teunenbroek et al does not support a rejection of claim 69 under 35 U.S.C. §102(b), and the rejection should be withdrawn. Because claims 25-28 and 70-71 depend directly or indirectly from claim 69, a rejection of these claims likewise would not be supported by Van Teunenbroek et al.

In addition, claim 72 requires the steps of “the first player providing a first set of game pieces that includes a first deformable game piece, each of the game pieces having a specific pattern of movement along a playing surface; the second player providing a second set of game pieces that includes a second deformable game piece; moving a first deformable game piece along the playing surface that has a plurality of designated positions; moving a second deformable game piece along the playing surface; engaging the first game piece with the second game piece; and moving the engaged game pieces relative to each other to cause a deformation in one of the engaged game pieces.” These steps are not taught or suggested by Van Teunenbroek et al. Thus, Van Teunenbroek et al does not support a rejection of claim 72 under 35 U.S.C. §102(b), and the rejection should be withdrawn. Because claims 19, 30-31, 49-55 and 73 depend directly or indirectly from claim 72, a rejection of these claims also would not be supported by Van Teunenbroek et al.

Rejections Under 35 U.S.C. §103

Claims 18-31 and 33-61 are rejected under 35 U.S.C. §103(a) as being unpatentable over Van Teunenbroek et al. Further, claims 18-31 and 33-61 are rejected under 35 U.S.C. §103(a) as being unpatentable over Van Teunenbroek et al in view of Ferris et al. (US 4,563,011). Additionally, Claims 18-31 and 33-61 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ferris et al. As indicated above, claims 18, 33-44, 48 and 56-61 have been canceled without prejudice by this amendment. Therefore, the rejection of claims 18, 33-44, 48 and 56-61 is believed to be moot.

However, the Applicant respectfully traverses the rejection of claims 18, 24 and 29, which have been rewritten in independent form as new claims 62, 69 and 72, on the

grounds that the cited references, both individually or in combination, do not teach or suggest the features of these claims.

Van Teunenbroek et al.:

The Patent Office states in its rejection that “Teunenbroek teaches all limitations except that it does not expressly teach game being played in a board game environment having designated positions and playing pieces moving, engaging and being deformed.” The Applicant respectfully disagrees that Van Teunenbroek et al teaches all limitations except those specifically identified by the Patent Office. For example, as provided previously, Van Teunenbroek does not teach or suggest that a set of toy articles are used, with two or more toy articles in the set having specific patterns of movement on the playing board. Nor does Van Teunenbroek et al teach or suggest that one of the toy articles in the set is chosen to be a king. In fact, Van Teunenbroek et al does not describe any rules of a game that is to be played, i.e. movement along a playing board, different classes of toy articles, board positioning, etc.

The Patent Office further states that Van Teunenbroek et al teaches “that the apparatus can be used in various games and competitions (4:9-11) for commercial purposes.” Van Teunenbroek et al goes on to indicate examples of such “games and competitions”. More specifically, Van Teunenbroek et al describes “adding the toy article to bags of crisps or boxes of cornflakes, and wherein a day is organized on which everybody who thinks he or she has a very strong specimen can participate in the finals.” (Col. 4, lines 11-16). The reference also discusses the toy article functioning as a collector’s item. (Col. 4, lines 16-18). Further, the toy article can function as a coupon, whereby ten specimens can be traded for a bottle of soft drink or a tube of toothpaste. (Col. 4, lines 20-23). Other equally inapplicable and irrelevant examples are also provided. (Col. 4, lines 24-30 and lines 38-43). However, none of these examples teach or suggest rules for moving, engaging, positioning, grouping or selecting the toy articles for movement along a game board having designated positions and/or for the steps included in rejected claims 18, 24 and 29 (now claims 62, 69 and 72).

Van Teunenbroek et al in view of Ferris et al, and Ferris et al individually:

The Patent Office states in its rejection that "Teunenbroek teaches all limitations except that it does not expressly teach game being played in a board game environment having designated positions and playing pieces moving, engaging and being deformed." As provided above, the Applicant respectfully disagrees that Van Teunenbroek teaches all limitations other than those specifically identified by the Patent Office.

Further, Ferris et al is directed toward a board game that uses a toy "big foot" vehicle and a crushable car. The big foot vehicle and the crushable car have different configurations. There is no selection of which toy will be the big foot vehicle and which will be the car(s). They are pre-configured in this manner. (Col. 2, lines 31-37). The big foot vehicle is designed to "crush" the crushable car when the big foot vehicle is forced downward on the car. (Col. 2, line 67 to Col. 3, line 1). In other words, the ability of the big foot vehicle to crush the car is dependent upon the disparity in size, shape and configuration of the vehicle versus the car. For instance, the car is crushable; the big foot vehicle is not.

Thus, the cited references, either individually or in combination, do not teach or suggest that a set of substantially similar toy articles are used, with two or more toy articles in the set having specific patterns of movement on the playing board. Nor do the cited references teach or suggest that one of the toy articles in the set is chosen by the player to be a king. Moreover, the cited references do not teach or suggest removing the deformed game piece from the playing surface at any time during the game. Consequently, the cited references do not support a rejection under 35 U.S.C. §103(a) of claims 62, 69 and 72. Therefore the rejection of these claims should be withdrawn and the claims should be allowed. In addition, the claims that depend from claims 62, 69 and 72 should also be allowed.

New Claims

In addition to new claims 62-73 discussed previously herein, new claims 74-80 have been added by this amendment. New claims 74-80 are of a slightly different scope

than the previously pending claims. However, in view of the cited references, these claims are believed to be allowable.

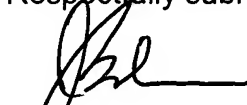
For example, in direct contrast to the cited references, new claim 74 requires the steps of "the first player providing a first set of deformable game pieces that are substantially similarly configured relative to one another; the second player providing a second set of game pieces that are substantially similarly configured relative to one another; moving a first deformable game piece along a playing surface having a plurality of designated positions; moving a second deformable game piece along the playing surface; engaging the first game piece with the second game piece; and moving the engaged game pieces relative to each other to cause a deformation in one of the engaged game pieces." These steps are not taught or suggested by the cited references. Therefore, claim 74 is believed to be allowable. Because claims 75-80 depend directly or indirectly from claim 74, they are likewise believed to be allowable.

Conclusion

In conclusion, Applicant respectfully asserts that claims 19-23, 25-28, 30-31, 45-47, 49-55 and 62-80 are patentable for the reasons set forth above, and that the application is now in a condition for allowance. Accordingly, an early notice of allowance is respectfully requested. The Examiner is requested to call the undersigned at 858-487-4077 for any reason that would advance the instant application to issue.

Dated this 28th day of April, 2005.

Respectfully submitted,



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